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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,616	05/23/2001	Yasushi Kasajima	125A 3124	8821

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EXAMINER

COFFY, EMMANUEL

ART UNIT	PAPER NUMBER
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2157

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/863,616	Applicant(s) KASAJIMA, YASUSHI	
	Examiner Emmanuel Coffy	Art Unit 2157	

SK

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2001.
 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-15 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☒ The drawing(s) filed on 23 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the application filed on May 23rd, 2001. Claims 1-15 are pending. Claims 1-15 are directed to a method for a "Method and system for automatically transferring electronic mail over a communication network, communication server apparatus, automatic transfer and intermediary communication server apparatus and communication server apparatus for information service."

Claim Objections

2. Claims 9, 10, 12, 13 and 14 are objected to because of the following minor informalities.

A colon (:) should follow the transitional phrase (e.g. comprising), which delineates the preamble of the claim. Appropriate correction is required.

3. In claim 6, the verb "is" in "...transferring has expires is transferred to a..." should be removed. Appropriate correction is required.

4. The examiner objects to the language of claims 6 and 11. Claim 6 should read: "...automatic transfer has expired is transferred to a..." and claim 11 should read: "... image information is attached to said electronic mail message..." Applicant is advised to perform the corrections as indicated.

Claim Rejections - 35 USC § 112

Claims 11 and 14 are rejected.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 11 and 14 are rejected under 35 U.S.C. §112 ¶2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention due to ambiguous language. A reasonable artisan skilled in the art could not comprehend the claims as written. The claims recite: "...and the like..."

The phrase "and the like" renders the claim indefinite because the claim includes elements not actually disclosed (those encompassed by "and the like"), thereby rendering the scope of the claim unascertainable. See MPEP § 2173.05(d). This is applicable to all other claims where the phrase "and the like" is found. Furthermore, every claim which claims dependency on a claim rejected under this paragraph is rejected by virtue of said dependency.

Claim Rejections - 35 USC § 102

The following is a quotation of the second paragraph of 35 U.S.C. 102:

A person shall be entitled to a patent unless-

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claim 1 directed to a method is rejected under 35 USC 102(e) as being clearly anticipated by Moon et al. (US 6,138,146).

Moon teaches a mail forwarding system having a server, a fixed computer and a router for connection to a public network external to a private network, all interconnected via a data connection, with the server controlling electronic mail

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resources addressed to a user of the fixed computer received by the private network.

(See abstract).

Claim 1:

Referring to claim 1, Moon teaches the invention as claimed including a method for automatically transferring an electronic mail over a communication network, said method comprising the steps of: (See Fig. 1 and Fig. 7).

sending from a communication terminal unit, an electronic mail message together with a transfer trigger condition, which is made according to predetermined rules specified by event information, to a communication server apparatus equipped on said communication network, (See col. 6, lines 3-25).

receiving and registering at said communication server apparatus said electronic mail together with said transfer trigger condition, and (See col. 6, lines 3-10 and Fig. 7 (48)).

watching at said communication server apparatus said transfer trigger condition after registration of said electronic mail message whether or not said condition meets a predetermined condition and automatically transferring the corresponding electronic mail message to a communication terminal unit to be transferred when detecting said transfer condition meets said predetermined condition. (See col. 2 lines 30-33 and col. 6, lines 20-25).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2-15 are rejected under 35 U.S.C. §103(a) as being unpatentable over Moon et al. (US '146) in view of Lazaridis et al. (US 6,219,694.)

Claim 2:

Referring to claim 2, Moon substantially teaches the invention including a method for automatically transferring an electronic mail over a communication network, said method comprising the steps of:

sending from a communication terminal unit an electronic mail message together with a transfer trigger condition, which is made according to predetermined rules specified by event information, to an automatic transfer and intermediary communication server apparatus equipped on said communication network, (See col. 6, lines 3-25).

receiving and registering at said automatic transfer and intermediary communication server said electronic mail message and allocating an individual identification code to said registered electronic message and thereafter sending said transfer trigger condition corresponding to registered electronic mail message together with said allocated identification code to the predetermined destination communication terminal unit, said identification code being allocated to said respective electronic mail

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message registered at said automatic transfer and intermediary communication server, (See col. 6, lines 3-10).

watching at said destination communication terminal unit whether or not said transfer trigger condition received meets a predetermined condition and sending to said automatic transfer and intermediary communication server automatic transfer command together with said identification code corresponding to said electronic mail message of which transfer trigger condition meets when said transfer trigger condition meets the predetermined condition, and

automatically transferring from said transfer and intermediary communication server apparatus the corresponding registered electronic mail specified by said identification code sent from said destination communication terminal unit to a communication terminal unit to be transferred, on receiving said automatic transfer command from said destination communication terminal unit. (See col. 2 lines 30-33 and col. 6, lines 20-25).

Moon teaches a mail forwarding system having a server, a fixed computer and a router for connection to a public network external to a private network, all interconnected via a data connection, with the server controlling electronic mail resources addressed to a user of the fixed computer received by the private network. (See abstract). Moon does not specifically teach allocating an individual identification code to said registered electronic message and thereafter sending said transfer trigger condition corresponding to registered electronic mail message together with said allocated identification code to the predetermined destination communication terminal

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unit. However, Lazaridis teaches placing an outer wrapper (Identification) about the original message and by providing the addressing information of the communication terminal unit to be transferred. (See col. 10, line 66-col. 11, line 5).

Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to combine the electronic mail forwarding system taught by Moon with the allocation of individual identification code disclosed by Lazaridis. Such a system would allow a user to forward messages to different classes or types of equipment.

Therefore, claim 2 is rejected.

Claim 3:

Referring to claim 3, Moon substantially teaches the invention as claimed including the method of claim 1 or 2, wherein said transfer trigger condition contains information on the operation of a facility or equipment to be notified to said communication server apparatus as said event information.

Moon teaches a mail forwarding system having a server, a fixed computer and a router for connection to a public network external to a private network. (See abstract). Moon does not specifically teach trigger condition that contains information on the operation of a facility or equipment to be notified by said communication server apparatus as said event information.

However, Lazaridis teaches the detection of redirection event (See col. 4, line 19-24) to push certain user-selected data items such as attachments (See col. 6, lines 61-64 and col. 3, lines 50-56).

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Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to combine the electronic mail forwarding system taught by Moon with the detection of redirection event disclosed by Lazaridis. Such a system would allow a user to forward users' manuals and other manuals to different classes or types of equipment. Therefore, claim 3 is rejected.

Claim 4:

Referring to claim 4, Moon substantially teaches the invention as claimed including the method of claim 1 or 2, wherein said transfer trigger condition contains as said event information, command information or information on location of specific terminals both sent from a service server apparatus or communication terminal unit, each of which is two-way communicable with said communication server apparatus on a communication network.

Moon teaches a mail forwarding system having a server, a fixed computer and a router for connection to a public network external to a private network. (See abstract). Moon does not specifically teach information on location of specific terminals sent from a service server apparatus or communication terminal unit, each of which is two-way communicable with the communication server apparatus on a communication network.

However, Lazaridis teaches information on location of specific terminals (See col. 7, line 16-19) sent from a service server apparatus or communication terminal unit, each of which is two-way communicable with the communication server apparatus on a communication network. (See col. 6, lines 37-48).

Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to combine the electronic mail forwarding system taught by Moon with two-way communication of specific terminal's location disclosed by Lazaridis. Such a system would allow a user to replicate user-selected data items from the server to a mobile device. Therefore, claim 4 is rejected.

Claim 5:

Referring to claim 5, Moon substantially teaches the invention as claimed including the method of claim 1 or 2, wherein said transfer trigger condition is added an expiry date of automatic transferring for said registered electronic mail message.

Moon teaches a mail-forwarding program which includes a timing routine. (See col. 6, lines 16-25 and col.6, line 63-col. 7, line 5). Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to use the electronic mail forwarding system which includes a timing routine as taught by Moon. Therefore, claim 5 is rejected.

Claim 6:

Referring to claim 6, Moon substantially teaches the invention as claimed including the method of claim 1 or 2, wherein said electronic mail of which expiry date for automatic transferring has expired is transferred to a communication terminal unit to be transferred or is erased, when the corresponding expiry date set in said transfer trigger condition expires.

Moon teaches a mail-forwarding program which includes a timing routine. (See col. 6, lines 16-25 and col.6, line 63-col. 7, line 20). Hence, it would have been obvious

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at the time of the invention for an artisan of ordinary skill in the art to use the electronic mail forwarding system which includes a timing routine as taught by Moon. Therefore, claim 6 is rejected.

Claim 7:

Referring to claim 7, Moon substantially teaches the invention as claimed including the method of claim 1 or 2, wherein said communication server apparatus sends a transfer completion notice to the communication terminal unit of the sender after completing transfer of the corresponding electronic mail message according to said transfer trigger condition.

Moon teaches a mail-forwarding program which includes transmission of a notification signal. (See col. 7, lines 39-63). Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to use the electronic mail forwarding system which includes transmission of a notification signal as taught by Moon. Therefore, claim 7 is rejected.

Claim 8:

Referring to claim 8, Moon substantially teaches the invention as claimed including the method of claim 1 or 2, wherein said communication server apparatus sends a transfer failure notice to the communication terminal unit of the sender when having fail to transfer the corresponding electronic mail message according to said transfer trigger condition.

Moon teaches a mail-forwarding program which includes transmission of a notification signal. (See col. 7, lines 39-63). Moon does not specifically teach a transfer

failure notice. However, Lazaridis teaches setting a trigger flag if a received message or signal is a trigger event or not.

Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to combine the electronic mail forwarding system which includes transmission of a notification signal taught by Moon with the flag setting event as disclosed by Lazaridis. Such a system would allow a user to be cognizant of a system failure. Therefore, claim 8 is rejected.

Claim 11:

Referring to claim 11, Moon substantially teaches the invention as claimed including the system of claim 9 or 10, wherein a media file where at least either one of audio information, image information and the like is stored is attached to said electronic mail message, wherein said communication terminals unit to be transferred said electronic mail message is such one as TV set or telephone set connected to an indoor information network system, and wherein said communication server apparatus automatically opens said media file to out put the contents of said media file into said communication terminals, when transferring said electronic mail message according to said transfer trigger condition.

Moon teaches a mail forwarding system having a server, a fixed computer and a router for connection to a public network external to a private network. (See abstract). Moon does not specifically teach media file transferred to communication terminals such as TV set or telephone set connected to an indoor information network system, and wherein said communication server apparatus automatically opens said media file to out

put the contents of said media file into said communication terminals, when transferring said electronic mail message according to said transfer trigger condition.

However, Lazaridis teaches media file (See col. 6, line 21-22) transferred to communication terminals such as TV set or telephone set connected to an indoor information network system, and wherein said communication server apparatus automatically opens said media file to out put the contents of said media file into said communication terminals, when transferring said electronic mail message according to said transfer trigger condition. (See col. 6, lines 10-15, 31-36; col. 8, lines 56-65).

Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to combine the electronic mail forwarding system taught by Moon with transfer of media file as disclosed by Lazaridis. Such a system is a more automated system allowing the user to control both the server and the receiving device. Therefore, claim 11 is rejected.

Claim 15:

Referring to claim 15, Moon substantially teaches the invention as claimed including a communication server apparatus for information service equipped on a communication network having a specific template to fill transfer trigger condition according to a predetermined rule specified by event information therein, said communication network enabling a communication terminal unit accessing thereto to download said template over a communication network.

Moon teaches a mail forwarding system having a server, a fixed computer and a router for connection to a public network external to a private network. (See abstract).

Moon does not specifically teach specific template to fill transfer trigger condition according to a predetermined rule specified by event information therein. However, Lazaridis teaches configuring and setting-up the user-defined event trigger points; (See col. 10, line 40-45) whereby a communication terminal unit can access the network to download said template over a communication network. (See col. 6, line 56-col. 7, line 7; col. 9, lines 51-64).

Hence, it would have been obvious at the time of the invention for an artisan of ordinary skill in the art to combine the electronic mail forwarding system taught by Moon with the downloading and configuration user-defined event trigger points capabilities as disclosed by Lazaridis. Such a system would afford the user more flexibility than other available systems. Therefore, claim 15 is rejected.

Claims 9-10, 12-14:

These claims are not specifically addressed because they fail to teach or define any significantly new limitation above and beyond claims 1-8 and 11 to warrant particular treatment, and therefore are rejected for similar reasons.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Yamauchi et al. (U.S. 5,974,448) teaches "Automatic Transfer For Electronic Mail Using An Automatic Transfer Name As a Keyword."

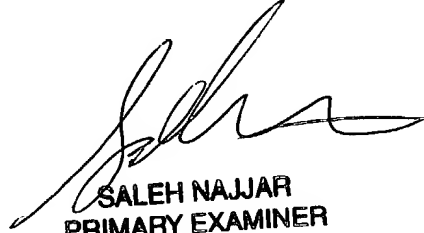
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emmanuel Coffy whose telephone number is (703) 305-0325. The examiner can normally be reached on 8:30 - 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (703) 308-7562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Emmanuel Coffy
Patent Examiner
Art Unit 2157

EC
Aug 27, 2004



SALEH NAJJAR
PRIMARY EXAMINER